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In re Application of: KENNETH A. FRANKEN ET AL.) **DECISION ON PETITION FOR**
Application No.: 09/681,172) **ACCELERATED EXAMINATION**
Filed: February 08, 2001) **UNDER M.P.E.P. §708.02(VIII)**
For: **INDIVIDUALIZED CONTENT GUIDE**)

This is a decision on the petition, filed April 11, 2002 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special. The delay in this decision is sincerely regretted.

The petition is **DISMISSED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a **single invention**, or if the Office determines that all the claims presented are not obviously directed to a single invention, **will make an election without traverse** as a prerequisite to the grant of special status.
- (C) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (E) Submits a **detailed discussion** of the references, which discussion points out, with the **particularity** required by 37.CFR 1.111(b) and (c), **how** the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

A review of the file history reveals that:

1. Petitioner, on April 11, 2002, submitted a petition for accelerated examination under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII). At the same time, Petitioner filed a Supplemental Information Disclosure Statement.

2. Petitioner submitted one copy each of the four references cited in the European Standard Search Report dated August 02, 2001, which were deemed most closely related to the subject matter encompassed by the claims. Petitioner stated that "EPO suggested that the above references relate to claims 1-8, 10-15, 17-19 [of the instant application]. Claims 9, 16, and 20 were not cited as having a reference relating to them." As a result, Petitioner cancelled all claims, via a preliminary amendment, except for claims 9, 16, and 20, and stated that "[i]n view of the deletion of these claims, the Applicants believe that the application, as amended, is now clearly patentable because the claims against which references were cited have been deleted."

Petitioner's submission is deficient in that it does not comply with items (B) and (E) above:

1. Petitioner's submission did not contain any language regarding the claims being directed to a single invention or that Applicant will make an election without traverse if the Office determines that all claims are not obviously directed to a single invention.

2. Petitioner's submission does not provide a **detailed** discussion of the references, which points out, with the **particularity** required by 37 CFR 1.111(b) and (c), **how the claimed subject matter is patentable over the references**. Petitioner's cancellation of claims 1-8, 10-15, and 17-19 without providing a detailed discussion of the references which particularly points out how the subject matter of claims 6, 9, and 20 is patentable over the references does not meet the requirement of item (E) above. Moreover, Petitioner's statement in the Supplemental Information Disclosure Statement filed April 11, 2002 to the effect that Petitioner's submission of any document, including the European Standard Search Report dated August 02, 2001, shall not "be construed as an admission that the information cited is, or is considered to be, material to patentability, or as an admission against interest in any manner." This statement contradicts and therefore does not comply with item (E), which requires Petitioner to discuss how the claimed subject matter is patentable over the references.

For the above-stated reasons, the Petition is **DISMISSED**. Because the Examiner of Record, on August 07, 2003, examined this application and issued an Office letter, the application file is being forwarded to the Examiner of Record for its normal course.

Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision.



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